

REMARKS

The abstract has been rewritten along the lines suggested by the Examiner..

The claims in the application were claims 1-10. By this amendment claims 1-3, 5 and 7-9 are amended to incorporate the limitations of claim 6 and to recite preferred embodiments of applicants' invention that are more clearly distinguished from the prior art. Claims 4, 6, and 10 are canceled and new claims 11-13 are introduced. Thus, claims 1-3, 5, 7-9 and 11-13 remain.

Applicants' invention is directed at an electronic system and method for increasing the efficiency, cost effectiveness, and/or quality of the purchasing process, especially shopping in a super market. The system utilizes stored product data, the client's purchasing history and background, and environmental data to generate via predictive algorithms, an ordered shopping list. The list is sorted by specific parameters, e.g. probability, frequency and cost, and is presented to the client in an ordered fashion. The client can amend the list electronically, input additional data, e.g., "having a birthday party", and/or finalize the purchase. Thus, the instant system and method are very much about facilitating the filling of orders that primarily occur with high frequency and that involve multiple products, e.g., saving the client time and/or money shopping at a supermarket. [See, for example: page 2, line 24-29; page 3, line 20 – page 4, line 12; page 7 Table 1; page 8, line 20-32; and page 15, line 23- page 16, line 20.]

In an office action mailed October 8, 2004, claims 1-4 and 8-10 were rejected under 35 USC. 103(a) as being unpatentable over Suzuki (U.S. 6,129,274). Applicants respectfully traverse these rejections based on the following arguments.

Suzuki is directed at an electronic, computerized system that is able to collect and store customer transaction history information in real-time and make

that information available to a department store or chain store POS [point of sales], or other in-store terminal, such that the customer's transaction history data is always up-to-date (Column 3 lines 54-59). Suzuki is silent about cost-effectiveness and reduction of time needed for the production of orders. (see column 3, lines 54-64 of this document). Thus, the system disclosed by Suzuki is designed to expand the shopping list already generated by the client, with, for example promotional items, and not to facilitate the filling of orders.

Suzuki is silent about the presentation of a suggested shopping list to the client in an ordered manner in general and in particular, a list sorted using the criteria recited in applicants' amended claim 1. Furthermore, Suzuki is silent about an interaction means for electronically amending the proposed list. Both are essential features of the system of the invention, which are not known from Suzuki.

The Examiner maintains that it would have been obvious for a person of ordinary skill in the art to modify Suzuki to arrive at applicants' claimed invention. Because Suzuki is directed at efficiently capturing purchase transactions and not facilitating the shopping process by generating a shopping list, ordering the list by the criteria set forth in claim 1 and providing an interactive capability would not lead to an improvement of the Suzuki system. In fact, such modifications would have been seen as counterproductive to the objective of the Suzuki invention, i.e., efficient recording of purchases on a magnetic card, because they introduce unnecessary or irrelevant steps. Thus, the person of ordinary skill would have had no motivation to modify Suzuki to arrive at applicants' invention.

In the office action, previously presented claim 5 was rejected under 35 USC 103(a) as being unpatentable over Suzuki in view of Pyo (U.S. 6,636,836).

Pyo teaches a software system that utilizes a variety of analyzing methods to make better recommendation for goods and services that are predicted to be

interesting to individual tastes. An integral part of the method requires feedback from the individual to adjust the relative weights of the analyzing methods so as to make better predictions for future recommendations. The Examiner maintains that it would have been obvious to one of ordinary skill to modify the system and method of Suzuki to implement the predictive methods of Pyo in order to achieve better predictive results, and thereby boost sales. Applicants respectfully disagree.

As discussed above, the objective of the Suzuki system is the efficient and timely capture of purchase transactions. Suzuki does not contain an interaction means and provides no indication or suggestion to use such an interaction means for electronically amending an order in the electronic, computerized system disclosed therein – an essential feature that would have been required utilize the software of Pyo. Thus, there would not have been motivation to combine the references let alone to have used Pyo to transform Suzuki's transaction recording system into a purchase order generating system.

In the office action, previously presented claims 6 and 7 were rejected under 35 USC 103(a) as being unpatentable over Suzuki in view of Bieganski (U.S. 6,321,221).

Bieganski is directed at overcoming the problem that known "recommender" systems - although able to recommend items with high confidence level often recommend items that are obvious to the user; in other words, to overcome the problem of making low-value recommendations. Bieganski addresses this problem by providing an electronic processing system for generating a serendipity-weighted recommendation output. (see column 3, lines 17-22 as well as claim 1 of this document).

The Examiner maintains that it would have been obvious to one of ordinary skill at the time of the invention to have modified the system and method

of Suzuki to present recommendation in an ordered manner by numerical value, frequency, or estimated probability as taught by Bieganski, in order to more accurately assist the consumer with purchases, and thereby increase sales for the service. Applicants respectfully disagree.

As already discussed the Suzuki system is directed at the efficient and timely capture of purchase transactions and not the preparation of an ordered shopping list. Suzuki does not contain any indication or pointer, which would have directed a skilled person in the direction of the teachings of Bieganski, i.e., the desirability of a serendipity based system to generate high level recommendations for goods.

Furthermore, even in the unlikely event Suzuki and Bieganski were combined, this combination would not have yielded applicants' invention for the following reason. Bieganski states that in many cases if the recommender system has sufficient data to have high confidence that a recommendation will be good, then the recommendation will be obvious to the user. Further "If the recommendation is obvious, then the recommendation system has provided no-value." This point is illustrated in the case of buying milk where the recommendation to buy milk is not regarded as being helpful [column 2, line 67 to column 3, line 13]. Thus, the entire focus of the serendipity based algorithms taught by Bieganski, is the recommendation of items that are new, albeit interesting, to the consumer.

In contrast, applicants' invention is geared to preparing accurate lists for the repetitive purchases of multiple items along with some new items especially those depending upon environmental factors or additional consumer (a birthday or a football match). Furthermore, the sorting of recommendations by estimated probability of purchase, frequency of purchase and cost of items as recited in applicants amended claim 1 are actually counter to the focus of Bieganski. For

example, putting the right quantity of milk on the shopping list at the right frequency is indeed one of the things applicants' invention seeks to ensure.

In summary, when knowing the references cited by the examiner and faced with the above problem addressed by the present invention, a person of ordinary skill in the art would not have been motivated to modify Suzuki or combine its teachings with Pyo or Bieganski. Furthermore, even if the teaching of these references would have been combined, then that would not have lead in the direction of the present invention.

Based on the amended claims and the above arguments, applicants respectfully request that the 103(a) rejection over Suzuki (U.S. 6,129,274) individually or in combination with Pyo (U.S. 6,636,836) or with Bieganski (U.S. 6,321,221) be reconsidered and withdrawn and that the application be allowed to issue.

If a telephone conversation would be of assistance in advancing prosecution of the subject application, applicants' undersigned agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



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